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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JOHN G POSA
GIFFORD KRASS GROH PATMORE
ANDERSON & CITKOWSKI
280 N WOODWARD AVE SUITE 400
BIRMINGHAM, MI 48009

EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 07/31/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

24

Office Action Summary

Application No.

08/822,397

Applicant(s)

SCHWAB ET AL.

Examiner

Brown M. Reuben

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 18-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 18, 26 & 34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 36 & 39-40 are objected to under MPEP 608.01(i). The instant claims presently depend from claim 34 and include the recitation of, "the descriptive information". However, the recited feature is introduced in claim 35, thus it appears that claims 36 & 39-40 should depend from claim 35. Correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 24 & 25 are rejected under 35 U.S.C. 112, second paragraph, as lacking antecedent basis. Claims 24 & 25 recite the limitation "the pointer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 26-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed feature of amended claim 26 of, "transmitting, from a broadcaster to the viewing location, a TV program on a primary transmission medium, the program including additional information fro directing the channel selector to automatically switch, at least temporarily to one or more *secondary transmission media*", is not found in the specification, emphasis added.

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On page 5 of the specification, it is disclosed that a primary channel may include additional information for directing a second tuner to a secondary channel. However, the specification does not explicitly state that this secondary channel may be on a transmission media different from the primary channel.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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8. Claims 18-25 & 34-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Hofman, (U.S. Pat # 5,883,677).

Considering amended claim 18, the claimed feature of automatically changing to an alternative transmission medium at a TV viewer location, comprising the step of entering at the viewer location, information regarding a viewing preference is broad enough to read on a viewer changing the source input at a multisource receiver. Hofman is directed to a customer premise that comprises a multisource receiver, i.e., gateway 110, which receives TV signals from at least CATV, DBS and telecommunication mediums, see Fig. 1 & Abstract. The instant claim also recites the feature of transmitting a TV program from a broadcaster to a viewer location, receiving the TV program at the viewer location over a first transmission medium and automatically switching the program to the alternative transmission medium, based on the information entered by the viewer.

The above-recited feature is also broad enough to read on a network gateway enabled to receive TV input from multiple sources, such that a viewer then can choose to receive a particular TV from either one of the sources, which carries the instant TV program. Hofman teaches that a user is enabled to choose between TV source inputs, such as broadcast, CATV or satellite, (Fig. 1; Fig. 2; Abstract; col. 6, lines 31-45).

Hofman discloses a menu, which is generated by merging the database from a plurality of TV providers, such as CATV & DBS, wherein the source of the TV program may also be

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included in the interactive menu, see Fig. 9B & col. 8, lines 42-55. Even though Hofman doesn't explicitly state that a particular TV program may be received from different TV sources, such a feature is inherent. Clearly, the different TV providers offer one or more overlapping service providers, such as HBO, ESPN or CNN that are common to CATV as well as satellite TV. Moreover, clearly a particular movie may be received from multiple service providers. For instance, a particular movie may be distributed on multiple service providers, such as HBO, Showtime, TMC, etc. Therefore, Hofman inherently enables a customer to tune to a particular channel to receive a specific TV program from a first TV provider, and then switch to a second service provider. A user may receive the same channel/program from the same service provider, such as receiving ESPN from a CATV provider, and also from a DBS provider, see col. 6, lines 5-15.

Considering claim 19 & 37, Hofman teaches that the gateway receives CATV channels/programs, (Fig. 1).

Considering claims 20 & 38, Hofman teaches that the TV programs may be transmitted over a DBS system, which generally transmits video in a digital format. Also Hofman teaches that the system optionally supports, ADSL, which is a digital transmission protocol, (col. 5, lines 32-45).

Considering claim 21, Hofman inherently uses a remote-control unit for customer input.

Considering claim 22, Hofman teaches an on-screen program guide, (col. 3, lines 25-40).

Considering claim 23, Hofman teaches that program guide information is stored in memory and retrieved in order to present the merged database to the user, according to criteria, (col. 6, lines 15-40; col. 7, lines 44-58). This disclosure reads on the claimed subject matter.

Considering claim 34, the claimed TV system, comprising automatically changing the source of a transmission medium, in response to a user request is met by the disclosure of Hofman, (Abstract; col. 3, lines 28-46; col. 5, lines 45-56; col. 6, lines 5-15).

Considering claims 35-36, the claimed feature of entering descriptive information by a viewer is broad enough to read on a user entering a channel number, which causes the tuner to change the channel, and is inherently included in Hofman.

Considering claims 39-40, the instant claims are analyzed as best understood, in light of the above claim objections. The claimed feature is broad enough to read on a user issuing a channel change command either at the beginning of a TV program or continuously within the instant TV program.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's claims.

A) Hamlin Teaches a network interface terminal, which receives TV programming from a variety of sources, such as CATV, satellite and broadcast, for distribution to a customer, based on their selection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

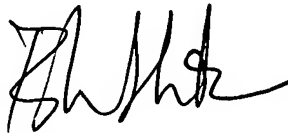
*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Brown M. Reuben whose telephone number is (703) 305-2399.
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the
organization where this application or proceeding is assigned is (703) 872-9314 for regular
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown


Bhavesh Mehta
Primary Examiner